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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/079,468	05/15/1998	AKIRA NISHIMURA	360842003400	8388

7590 06/08/2005

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EXAMINER

JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/079,468

Applicant(s)

NISHIMURA ET AL.

Examiner

Cheryl Juska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09/28/04 (Remand from Board of Appeals).
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35, 37-40, 43 and 44 is/are pending in the application.
4a) Of the above claim(s) 1-21, 29-35 and 37-39 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 22-28, 40, 43, and 44 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Response to Remand from the Board of Appeals

1. Pursuant to the Remand under 37 CFR 1.193(b)(1) by the Board of Patent Appeals and Interferences on September 28, 2004, PROSECUTION IS HEREBY REOPENED.

2. To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

3. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

4. The Board has asked for clarification of several issues. The first issue is the pendency of claim 40. Claims 1-35, 37-40, 43, and 44 are currently pending, with claims 1-21, 29-35 and 37-39 being withdrawn as non-elected. The Amendment After Final filed 05/15/03, which proposed to cancel claim 40, was NOT entered according to the Advisory Action of 05/28/03. The second Amendment After Final filed 06/16/03 was entered according to the Advisory Action of 07/09/03. However, the entry of the second AAF did not presume entry of the first AAF. Thus, claim 40 is still pending.

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5. The second issue is the rejection status of claims 40, 43, and 44. Although said claims were improperly omitted from the Examiner's Answer, the claims stand rejected under 103 over the Kishi and Homma references as set forth below.

6. Thirdly, it is noted that version of claim 22 present in the Appendix of the Appeal Brief is incorrect since it is not the last entered amended version (Amendment of 11/05/02). If applicant chooses to reinstate the appeal, a new brief in compliance with new rule 37 CFR 41.37 is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 22-28, 40, 43, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,447,785 issued to Kishi et al. in view of US 5,100,713 issued to Homma et al.

Kishi's patent is concerned with the creation of a cloth prepreg comprising a woven fabric impregnated with a resin. Kishi teaches a post-impregnated prepreg having a cover factor anticipating applicant's claimed cover factor (col. 14, lines 35-41). Kishi's fabric also discloses applicant's claimed crossing point ranges, width, yarn flatness, and area between openings of warp and weft (cols. 3-4, lines 40-10 and col. 10, lines 1-20). Said fabric woven from carbon fiber having a weight anticipating applicant's claimed weight (col. 11, lines 1-15). The resin may

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comprise a thermosetting phenol resin (col. 17, lines 45-60). Kishi teaches applying a sizing agent to the yarns (col. 10, lines 10-30).

Kishi is concerned with maintaining yarn flatness but fails to teach applying a binder in a line-like manner. Homma is concerned with the creation of an impregnated carbon fiber prepreg (abstract). Homma teaches applying a binder in a line-like manner to (col. 5, lines 42-50 and col. 6, line 54). Therefore, it would have been obvious to a person having ordinary skill in the art to use the line-like binder of Homma in the fabric of Kishi. Such a combination would have been motivated by the desire to increase a resin's ability to impregnate the prepreg (col. 6, lines 50-54), to aid in maintaining yarn flatness, and to increase the dimensional stability of the fabric.

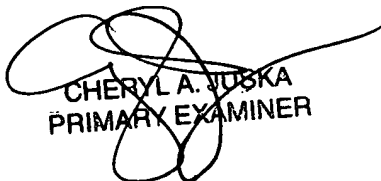
Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CHERYL A. JUSKA
PRIMARY EXAMINER

cj
April 7, 2005